

REMARKS**Summary of the Office Action**

In the Office Action, the drawings have been objected to.

Claims 19 and 20 stand rejected under 35 U.S.C. § 112, 2nd Paragraph.

Claims 14-23, 25 and 27 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 6,153,279 to *Charley*.

Claim 24 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Charley*.

Claim 26 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Charley* in view of U.S. Patent No. 5,458,282 to *Martin*.

Summary of the Response to the Office Action

Applicant proposes amending claim 1 and adding new claims 28-30. Accordingly, claims 14-30 are pending for further consideration.

Drawing Objections

In the Office Action, the drawings have been objected to for not including the features recited in claims 14 and 22-27.

As requested in the Office Action, Applicant herewith provides new Figs. 6 and 7, which illustrates the steps recited in 14, 22-25 and 27, and the postcard mailer recited in claim 26. No new matter has been added.

Applicant therefore respectfully requests withdrawal of the drawing objections with regard to claims 14 and 22-27.

Rejection under 35 U.S.C. 112, 2nd Paragraph

Claims 19 and 20 stand rejected under 35 U.S.C. 112, 2nd Paragraph.

Specifically the Office Action indicates that it is not clear whether two options (clear with printing, opaque with printing) or three options (clear, opaque, with printing) are intended.

With regard to claim 19, claim 19 recites the pressure sensitive carrier layer as having one of three configurations, clear, opaque or having printing thereon.

With regard to claim 20, claim 20 recites the pressure sensitive carrier layer as being a combination of clear, opaque and/or having printing thereon.

Based upon the aforementioned reasons, Applicant respectfully requests withdrawal of the 35 U.S.C. 112, 2nd Paragraph, rejection of claims 19 and 20.

All Claims are Allowable

In the Office Action, claims 14-23, 25 and 27 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 6,153,279 to *Charley*. Claim 24 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Charley*. Claim 26 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Charley* in view of U.S. Patent No. 5,458,282 to *Martin*. Applicant traverses these rejections for the following reasons.

With regard to independent claim 14, Applicant respectfully asserts that *Charley* and *Martin*, whether viewed singly or in combination, do not teach or suggest a method of manufacturing a clean release magnet, the method including the steps of, "printing information on a label layer having adhesive on at least one surface, thereby denoting a first layer; affixing a pressure sensitive carrier layer, having a clean release adhesive on a first surface and an adhesive on a second surface, to a magnet layer, to thereby denote a second layer; and affixing said first layer to said second layer, adjacent said magnet layer, to thereby denote a third layer, and simultaneously cutting said third layer to a predetermined depth, wherein said magnet layer is one of non-tacky and slightly-tacky when removed from said pressure sensitive carrier layer, and a surface of said magnet layer is exposed when removed from said pressure sensitive carrier layer such that when said exposed surface is magnetically attached to a metal surface, said exposed surface directly contacts the metal surface," as recited in independent claim 14, as amended.

Support for these features recited in claim 14 can be found at least in Paragraphs 21-25 and 29-39 of the originally filed specification, and in Figs. 1-4 of the originally filed drawings, and new Fig. 5. Specifically, as shown in Fig. 5, the present invention discloses a method of manufacturing a clean release magnet 10. The method includes the steps of printing information on a label layer (i.e. printed filmic face) 14 having adhesive on at least one surface, thereby denoting a first layer. The method further includes the step of affixing a pressure sensitive

carrier layer 11, having a clean release adhesive 13 on a first surface and an adhesive on a second surface, to a magnet layer 12, to thereby denote a second layer. The method also includes the step of affixing the first layer to the second layer, adjacent magnet layer 12 (see Fig. 1), to thereby denote a third layer, and simultaneously cutting the third layer to a predetermined depth. Based upon the aforementioned method, magnet layer 12 is non-tacky (or perhaps slightly-tacky) when removed from pressure sensitive carrier layer 11. Moreover, once removed, a surface of magnet layer 12 is exposed when removed from pressure sensitive carrier layer 11 such that when the exposed surface is magnetically attached to a metal surface, the exposed surface directly contacts the metal surface

The Office Action cites *Charley* and *Martin* as teaching or suggesting the method as recited in independent claim 14 of the present invention.

Charley, as illustrated in Fig. 2 and discussed in Col. 2:25-67, discloses a method of forming a label having a flexible magnet provided therewith. The label 10 disclosed by *Charley* includes from top to bottom, a printed material layer 14 adhered to a top surface 16 of flexible magnet 12, magnet 12 further including bottom surface 22 adhered to clear base material 20 by means of solvent based adhesive 29. Label 10 further includes clear film 24 adhered to liner 28 by means of adhesive backing 26. In operation, as illustrated in Fig. 2 and discussed in Col. 2:56-67, clear base material 20 may be separated from clear film 24 by means of the chemical bonding between the two layers. Specifically, as discussed in Col. 2:58-62, it is stated that clear base material 20 and clear film 24 are formed of Technicote Magic Film™, which consists of two film layers that have been chemically bonded.

Applicant respectfully asserts that the chemical bonding provided by the Technicote Magic Film™ disclosed in *Charley* is by no means equivalent in structure or operation, nor is it an obvious substitute for the clean release adhesive layer recited in independent claim 14 of the present invention.

Specifically, Technicote Magic Film™, which is well known in the art, includes two film layers which are chemically bonded. As discussed in Col. 2:62-63 of *Charley*, “[a] slight lifting pressure with a finger is enough to separate the two film layers.” Applicant respectfully asserts that while Technicote Magic Film™ is adequate for some applications which require the separation of different layers and attachment of the magnet layer onto a metallic surface, the

presence of a film (i.e. clear base material 20 for *Charley*) between the exposed magnet surface and the metallic object often results in an inadequate magnetic attraction between the magnet and the metallic surface. If the magnet of *Charley* is placed on a smooth surface, such as on top of one or more notes, or is used to retain objects between the magnet surface and the metallic surface, the aforementioned drawback is further compounded and results in an inadequate or virtually negligible magnetic attraction between the magnet and the metallic surface.

Taking precisely the aforementioned drawbacks into consideration (as well as the drawbacks discussed in paragraphs 3-6 of the originally filed specification), based upon extensive research and experimentation, Applicant herein determined the need for a label assembly including a magnet which could be readily bonded to a metallic surface, without the aforementioned drawbacks associated with a secondary film between the exposed magnet surface and the metallic object. Applicant thus invented the clean release magnet and the associated method of producing the same according to the present invention which overcomes the aforementioned drawbacks of *Charley*, and further provides a magnet label which is economically and feasibly simpler to manufacture, as well as a magnet label which has gained remarkable consumer acceptance since its introduction into the label market.

For at least these reasons, Applicant respectfully asserts that *Charley* does not teach or suggest a method of manufacturing a clean release magnet, the method including the steps of, "printing information on a label layer having adhesive on at least one surface, thereby denoting a first layer; affixing a pressure sensitive carrier layer, having a clean release adhesive on a first surface and an adhesive on a second surface, to a magnet layer, to thereby denote a second layer; and affixing said first layer to said second layer, adjacent said magnet layer, to thereby denote a third layer, and simultaneously cutting said third layer to a predetermined depth, wherein said magnet layer is one of non-tacky and slightly-tacky when removed from said pressure sensitive carrier layer, and a surface of said magnet layer is exposed when removed from said pressure sensitive carrier layer such that when said exposed surface is magnetically attached to a metal surface, said exposed surface directly contacts the metal surface," as recited in independent claim 14, as amended.

With regard to the teachings of *Martin*, which has been cited herein for disclosing the magnet label attached to a postcard, Applicant respectfully asserts that *Martin*, as discussed

above for *Charley*, fails to teach or suggest the aforementioned limitations in independent claim 14, as amended.

Accordingly, *Charley* and *Martin*, whether viewed singly or in combination, fail to teach or suggest the invention as recited in independent claim 14 of the present invention.

As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. Of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Moreover, as pointed out in M.P.E.P. § 2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102 (b) should be withdrawn because *Charley* and *Martin* do not teach or suggest each feature of independent claim 14, as amended.

In view of the above arguments, Applicant respectfully requests the rejection of independent claim 14 under 35 U.S.C. § 102 be withdrawn. Additionally, claims 15-27, which depend from independent claim 14, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

New Independent claim 28

With regard to new independent claim 28, Applicant respectfully asserts that Applicant respectfully asserts that *Charley* and *Martin*, whether viewed singly or in combination, do not teach or suggest a method of manufacturing a clean release magnet, the method including the steps of, "providing a label layer having adhesive on at least one surface, thereby denoting a first layer; affixing a pressure sensitive carrier layer, having a clean release adhesive on a first surface and an adhesive on a second surface, to a magnet layer, to thereby denote a second layer; and affixing said first layer to said second layer, adjacent said magnet layer, to thereby denote a third layer, and simultaneously cutting said third layer to a predetermined depth, wherein said magnet layer is one of non-tacky and slightly-tacky when removed from said pressure sensitive carrier layer, and a surface of said magnet layer is exposed when removed from said pressure sensitive carrier layer such that when said exposed surface is magnetically attached to a metal surface, said

exposed surface directly contacts the metal surface," as recited in independent claim 28, as amended.

Applicant respectfully asserts that independent claim 28 is allowable at least for the reasons presented above for the allowance of independent claim 14, and the additional features recited therein. Additionally, claims 29 and 30, which depend from independent claim 28, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 04-2223. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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